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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/751,216

01/02/2004

Philip S. Siegel

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BAKER BOTTS L.L.P.

2001 ROSS AVENUE

SUITE 600

DALLAS, TX 75201-2980

EXAMINER

FISCHEITTI, JOSEPH A

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,216

Applicant(s)

SIEGEL, PHILIP S.

Examiner

Joseph A. Fischetti

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 10-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

Claims 1-16 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 09/817,353 in view of Roman et al and Haseltine '143. Roman et al. and Haseltine disclose obvious variants of the elements recited in claims 1-16

This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-8,10-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roman et al. in view of Haseltine'143

Roman et al. disclose a method of using the Internet to provide return labels to customers for facilitating returns of merchandise, comprising the steps of: receiving, from a customer, a request to initiate return processing (customer clicks on RETURN), via a web access tool associated with the customer (access tool is read as the computer on which the consumer is using and hence it is associated with him);

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displaying to the customer, here the consumer, return information at the web access tool (pp0019 "the system provides instructions for return shipping); receiving return-related data from the customer, via the web access tool (pp0015 clickreturns.com receives information from customer regarding receipt number etc.), thereby identifying a return item; and generating data for printing a return label (pp0020 consumer prints a packing slip). Regarding the limitations of a list of one transaction and return related data being elected from the list, applicant is directed to Roman et al. paragraph 0017 which explicitly states the display offers replacement or exchange. This display of two options for returns is read as a list. WEBSTER'S COLLEGIATE DICTIONARY TENTH EDITION defines a list, *inter alia*, as:

3. *n* the total number to be considered or included; *v.* ENUMERATE.

Clearly the display in Roman et al. lists the options of "replacement or exchange" and the user responds by choosing one of these as the selection from the list.

Regarding the limitation of accessing a database to obtain transaction information associated with customer, the transaction identifying at least one item of merchandise having been purchased by the customer in a prior purchase transaction, selection of an item of merchandise from the list from customer, reference is made to Haseltine'143 [0029] the bar code addressing a database which access information see par. [0028] of the sale. The bar code is deemed to access a list of at least one item. It would be obvious to modify Roman et al. to include Haseltine's information access feature the motivation

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being reducing the work required by the customer in remembering the details of the purchase.

Claim 2, wherein the displaying step is performed by displaying a return information web page (Roman et al. disclose page of click return.com is read as a web page).

Claim 3,4 official notice is taken regarding the old and notorious practice of generating a confirmation of a transaction on a separate page. See e.g., US6497408 par. 64. This official notice is hereby made final.

Claim 5: accessing a database to obtain customer information about the customer (see pp 0016 line 3), and wherein the displaying step includes displaying at least part of the customer information (Roman et al. disclose the offered replacement product and is read as part of customer information since it will reference the initial product).

Claim 6: accessing a database to obtain customer transaction information (see pp0016 line 3), and wherein the displaying step includes displaying at least part of the transaction information (the offered replacement product is read Roman et al. as transaction information since it will reference the initial purchased product).

Claims 7, 8: Roman et al. appears to be silent regarding a database dedicated to merchant return rules. However, Haseltine does disclose merchant specific rules for

returning products which are in a database tied to the packing slip identifier. It would be obvious to modify the method of Roman et al. to include the merchant specific return rules, the motivation being the ability to accommodate different business practices.

Re claim 10/11: performed prior to the downloading step, of determining whether the return is valid (see pp 0016 line 2 submitted return is analyzed for fraud against a database). Official notice is taken regarding the giving of notice that the request has been rejected and is made final. See e.g. US6192347 par. 517

Claim 12: see pp 0016 Roman et al.; e-tailer establish parameter e.g. rules to determining whether the return is valid.

Claims: 13/14/16: a merchant is notified of the return item (Roman et al. disclose information about the customer that he is returning the product undamaged) by the processing center pp0022 line 8).

Claim 15: Roman et al. disclose pp0020 consumer prints a packing slip which obviously includes the step of downloading the data for printing a return label to the web access tool.

Applicant argues that there is no disclosure in Haseltine of a web access tool, but Roman et al discloses an internet based return system. To make the connection to the database discussed in par 0029 of Haseltine et al. in the internet based system is an

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obvious modification. Applicant's arguments fail to take into account the further discussion found in par. 0029 of the label merely addressing an address in a memory housing the customer purchase information. It would obvious to modify Roman et al. to include Haseltine's information access feature the motivation being reducing the work required by the customer in remembering the details of the purchase.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Joseph A. Fischetti at telephone number (571) 272-6780.


Joseph A. Fischetti
Primary Examiner
Art Unit 3627

